

## REMARKS

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned “**Version with markings to show changes made.**”

Claims 1-19 were pending in the application. The Examiner has rejected Claims 1-19. Claim 2 has been amended. No new matter was added with this change. Support for this amendment can be clearly seen if Figure 1, for example. Claims 8 and 10 have been cancelled without prejudice. Applicant reserves the right to prosecute these claims in a related application.

### **2. Rejections under 35 U.S.C. § 102(b)**

The Examiner rejected Claims 1, 2, 4, 5, 11, 12, 13, 15, and 16 “under 35 U.S.C. 102(b) as being anticipated by Perrine (U.S. Patent 5,803,826).” Office Action, page 2. Applicant respectfully traverses the rejection.

The Examiner has stated that *Perrine* discloses “mark retaining surface means (12).” Applicant respectfully disagrees with the Examiner’s characterization of the cited reference.

The top sheet 12 of *Perrine* is “made from equally tough and resilient polyurethane, which is available in a wide variety of flexural moduli from a variety of manufacturers.” *Perrine*, Col. 5, Ins. 27-30. The top sheet 12 as disclosed simply is not “a mark retaining surface means for recording an impression resulting from contact with a golf club” as recited in claim 1. There is nothing inherent about top sheet 12, which the Examiner has referred to as disclosing “a mark retaining surface”, as recited in claim 1, which would retain a visible mark.

*Perrine* does disclose that “the top sheet 12 employed by in the present invention also permits a visible substance like a common, household spray-wax, or foamy soap solution, to be applied to it – to **temporarily register** the actual path of a golf head’s passing through the hitting area.” *Perrine*, Col. 8, Ins. 19-23, emphasis added. The mark left by the swipe of a

golf club through a liquid such as a soap solution is, as stated in the reference, temporary. A mark in a liquid such as a soap solution will begin to reflow in upon itself almost immediately. Thus, the impression is not recorded in such a liquid substance.

*Perrine* does not disclose all of the elements of independent claim 1. Thus independent claim 1 is patentable over the cited reference. Claims 2, 4, 5, and 11 are patentable at least for the reason of their dependence on claim 1.

With regard to claim 2, *Perrine* refers to bottom pad 14 as being "made from a relatively soft layer of foam rubber, woven fabric, etc." *Perrine*, Col. 6, lns. 27-28. *Perrine* simply does not disclose "a rubber mat operably secured to said base element, wherein said rubber mat underlies said base element," as recited in amended claim 2, emphasis added. *Perrine* discloses only the single layer of the bottom pad 14. Because the Examiner has used the bottom pad 14 of *Perrine* to illustrate the base element, see Office Action, page 2, this layer can not also illustrate the additional element of "a rubber mat operably secured to said base element, wherein said rubber mat underlies said base element," as recited in amended claim 2. Thus, *Perrine* does not disclose all of the elements of claim 2. Claim 2 is therefore also patentable for that reason.

With regard to claim 4, *Perrine* can not disclose that "said rubber mat is secured to said base element by adhesives", as recited in claim 4, because it does not disclose the separate elements of the rubber mat and the base element, as discussed with regard to claim 2, above. Claim 4 is allowable for at least this additional reason.

With regard to claim 5, the Examiner has referred to the following passage in *Perrine*. "The top sheet 12 has a completely smooth, and very low-friction surface, is resilient and tends to lie flat at rest, yet is relatively compliant/non-rigid. It is made of a suitable type, size

and thickness of sheet material such as plastic.” Perrine, Col. 5, Ins. 1-4. Yet the top sheet 12 of *Perrine* can not be used to illustrate the case “wherein said base element includes a substantially planar sheet of plastic”, as recited in claim 5. The top sheet 12 of *Perrine* has already been used by the Examiner to illustrate a different layer. See Office Action, page 2. Thus *Perrine* has failed to disclose the additional element of claim 5. Claim 5 is thus allowable for this additional reason.

Independent claim 12 is patentable for substantially the same reasons stated above with regards to claim 1. Claims 13, 15, and 16 are patentable for at least the reason of their dependence on claim 12. In addition, claim 15 is allowable for substantially the same reasons stated above with regard to claim 4.

Applicant respectfully requests withdrawal of this rejection.

**2. Claim Rejections -35 U.S.C. § 103(a): Obviousness**

**Claims 3 and 14**

The Examiner has rejected Claims 3 and 14 “under 35 U.S.C. § 103(a) as being unpatentable over Perrine.” Office Action, page 3. Applicant respectfully traverses this rejection.

*Perrine* discloses a bottom supporting pad 14 and a bottom sheet 117. See *Perrine*, Fig. 6. This bottom sheet 117 is added to allow for wrap around of the top sheet 112 and its subsequent fastening. See *Perrine*, Col. X, Ins. S. Because each of the other layers

Claim 3 is dependent upon claim 1. Claim 3 is patentable over the cited reference for at least the reasons stated above with regard to claim 1. Claim 14 is ultimately dependent upon claim 12. Claim 14 is patentable for at least the reasons stated above with regard to claim 12. Claims 3 and 14 are also patentable for the reasons of their dependence upon claim 1 and 12, respectively, in consideration of the arguments made with regard to those claims above. Applicant requests withdrawal of this rejection.

Claims 6, 17, and 19

The Examiner has rejected claims 6, 17, and 19 “under 35 U.S.C. 103(a) as being unpatentable over Perrine.” Office Action, page 3. Applicant respectfully traverses this rejection. With regards to claims 6 and 17, the recited limitation “a sheet of polycarbonate plastic” is a further limitation of the earlier limitation “base element” in claims 5 and 16, respectively. The Examiner has earlier referred to the base element as item 14 of *Perrine* on page 2 of the Office Action. In this rejection, the Examiner refers to “the top sheet (12)” with regards to this further limitation of the base element in claims 6 and 17. *Perrine* discloses that top sheet 12 “is relatively compliant/non-rigid.” *Perrine*, Col. 5, ln. 3. In fact, *Perrine* discusses an upper limit for rigidity of the top sheet in the invention. See *Perrine*, Col. 6, lns. 9-13. Thus, not only does *Perrine* not disclose item 12 as “a sheet of polycarbonate plastic,” as recited in claims 6 and 17, it specifically argues against the rigidity of such a modification. With regard to item 14, *Perrine* discloses “a low or medium density urethane foam” (Col. 6, lns. 42-43). There is clearly no motivation to modify either of the layers in *Perrine* to “a sheet of polycarbonate plastic” as recited in claims 6 and 17. In fact, “the respective properties of the top sheet 12 and the bottom pad 14 together enable the whole mat 10 to function.” *Perrine*, Col. 6, lns. 56-58. Thus, any modification of either of these layers of *Perrine* to become “a sheet of polycarbonate plastic,” as recited in claims 6 and 17, is discouraged.

Claim 19 is allowable for at least the reason of its dependence on claim 12.

Applicants request withdrawal of this rejection.

Claims 7, 8, and 18

The Examiner has rejected claims 7, 8, and 18 “under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Manheck (US patent No. 3,754,764).” Office Action, page 4. Claim 8 has been cancelled. Applicant respectfully traverses this rejection with regard to claims 7 and 18.

*Manheck* is directed to “providing an effective means for capturing the exact impact point of a golf ball on the face of a club, thereby permitting an instant, visual evaluation of where the club hits the ball immediately after each swing.” *Manheck*, Col. 1, lns. 40-45. This use contrasts with the invention of the present application in many ways. First, it involves the

strike of the club to the ball, and not the strike of the club to the ground as in the present invention. Second, it involves a modification to the golf club. Third, any multiple use of the sheet 24 of *Manheck* will involve distorting earlier marks. These points stand in stark contrast to “a sheet of no carbon required paper having one or more simulated golf balls printed thereon”, as recited in claims 7 and 18. Each of the simulated golf balls allows for the recording of a different swing with only the slight relocation of the golfer’s body to address a new position. Applicant asserts that these stark differences of end use and method of use discount any possibility of motivation to combine these references, as well as the fact that nowhere is taught or suggested a “sheet of no carbon required paper having one or more simulated golf balls printed thereon”, as recited in claims 7 and 18, in either of the references. Applicant asserts that claims 7 and 18 are patentable for at least the foregoing reasons. Applicant requests withdrawal of this rejection.

#### Claims 9 and 10

The Examiner has rejected claims 9 and 10 “under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436).” Office Action, page 5. Claim 10 has been cancelled. Applicant respectfully traverses this rejection with regard to claim 9.

Applicant asserts that claim 9 is patentable over the cited references for substantially the same reasons as the discussion of claim 7 and 18 above.

#### CONCLUSION

For the above reasons, Applicants respectfully request reconsideration and allowance of Claims 1-7, 9, and 11-19. Should the Examiner have any questions concerning this response, the Examiner is invited to call the Michael Guth at (831) 462-8270.

In summary, Claims 1-19 were pending in the application. Claims 1-19 were rejected. This response amended Claims 2. Claims 8 and 10 are cancelled. For the above reasons, Applicants respectfully request reconsideration and allowance.

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Respectfully submitted,



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**Version with markings to show changes made.**

The following provides a marked up version of the amended claims containing the newly introduced changes. Additions are in bold and underlined and deletions are in bold and [bracketed]. Claim 2 is amended.

2. (Amended) The golf practice mat of claim 1, **[wherein said base support includes]** **further comprising** a rubber mat operably secured to said base element, **wherein said rubber mat underlies said base element.**

8. (Cancelled).

10. (Cancelled).